

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Claims 2, 6, 9, and 13 were previously cancelled. Claims 15-28 and 30 were previously withdrawn in response to a restriction requirement. Claims 1, 3-5, 7, 8, 10-12, 14, 29, and 31-32 are pending in this application.

### **I. Rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 112**

In section 2 of the Office Action, Claims 8, 10-12, and 14 were rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. More specifically, the Examiner states:

Claims 8, 10-12 and 14 (filed 08/02/2007), the newly added limitations recite "A program storage device readable by a machine, tangibly employing a program of instructions executable by the machine to cause the machine to".

(Underlining added). Applicants respectfully disagree. Original Claims 8 and 12 recited "[a] program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method of recovering location information of a subscriber in a mobile network, the method comprising." Thus, the recited claim language is not a newly added limitation. The recited claim language corresponds directly to the language of Claims 8, 10-12, and 14 as originally filed.

According to M.P.E.P. § 2163.07, "[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible." Additionally, according to M.P.E.P. § 2163.I., "[i]t is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." (Underlining added). The recited claim language further clearly indicates "in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention" as required according to M.P.E.P. § 2163.I. Thus, Claims 8, 10-12, and 14 comply with the written description requirement. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 112.

**II. Rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 101**

In section 3 of the Office Action, Claims 8, 10-12, and 14 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. More specifically, the Examiner states:

Claim 8, 10-12 and 14 define "A program storage device readable by a machine, tangibly employing a program of instructions executable by the machine to cause the machine to". However, the specification does not define "A program storage device readable by a machine, tangibly employing a program of instructions executable by the machine to cause the machine to".

As discussed in Section I. above, the specification, which includes the claims as originally filed, does define "[a] program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to cause the machine to" as recited in Claims 8, 10-12 and 14. Therefore, Applicants respectfully submit that Claims 8, 10-12, and 14 are directed to statutory subject matter. As a result, Applicants respectfully request withdrawal of the rejection of Claims 8, 10-12, and 14 under 35 U.S.C. § 101.

**III. Rejection of Claims 1, 8, 29, 31, and 32 under 35 U.S.C. § 103(a)**

In section 6 of the Office Action, Claims 1, 8, 29, 31, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,763,233 to Bharatia (*Bharatia*) in view of US 6,839,323 to Foti (*Foti I*) and further in view of US 6,654,606 to Foti *et al.* (*Foti II*). Applicants respectfully disagree and respectfully submit that *Bharatia*, *Foti I*, and *Foti II*, alone and in combination, fail to teach, suggest, or describe all of the elements of at least independent Claims 1, 8, and 29.

Applicants respectfully submit that neither *Bharatia*, *Foti I*, nor *Foti II* teach "providing the TA and an address of the S-CSCF to a Home Subscription Server (HSS) for storage at the HSS" or "receiving the TA from the HSS" as recited in Claim 1, and similarly recited in Claims 8 and 29.

On pages 4-5 of the Office Action, the Examiner states:

The combination of Bharatia and Foti (US 6,839,323) does not specifically disclose providing the TA and an address of the S-CSCF to a Home Subscriber Server (HSS) for storage at the HSS, and receiving the TA from the HSS in response to a loss of the TA by the S-CSCF such that the TA is restored at the S-CSCF.

Foti (US 6,654,606) teaches providing the TA (see column 2, lines 9-24) and an address of the S-CSCF (column 2, lines 9-24) to a Home Subscription Server (HSS) for storage at the HSS (see column 2, lines 9-24), and receiving the TA from the HSS in response to a loss of the TA by the S-CSCF such that the TA is restored at the S-CSCF (also see column 2, lines 9-24, where Foti teaches HSS that stores transport address TA and CSCF in case a loss of the TA and CSCF, the TA and CSCF can be received from the HSS).

(Underlining added). Thus, the Examiner acknowledges that *Bharatia* and *Foti I* fail to teach at least these elements of Claims 1, 8, and 29. The Examiner looks to *Foti II* to provide these teachings.

The Examiner further states:

In response, Foti (US 6,654,606) does indeed teach providing the TA (see column 2, lines 9-24) and an address of the S-CSCF (column 2, lines 14-16, column 3, lines 31-34, column 4, lines 3-5 and column 4, lines 24-28) to a Home Subscription Server (HSS) for storage at the HSS (see column 2, lines 9-24), and receiving the TA from the HSS in response to a loss of the TA by the S-CSCF such that the TA is restored at the S-CSCF (also see column 2, lines 9-24, **where Foti teaches the HSS that stores transport address TA and CSCF**, and the TA and CSCF can be received from the HSS in case a loss of the TA and CSCF. If the TA and CSCF can not be received from the HSS, as alleged by the applicant, the HSS of Foti does not need to teach storing the TA and CSCF. A simple example, someone stores music or song on a CD, tape, floppy disk, so that the music or song can be received later by listening to the music or song. If the music or song can not be received, someone does not need to store the music or song).

(Pgs. 9-10; bolding and underlining in original). Applicants respectfully disagree with the Examiner's interpretation of *Foti II*.

At column 2, lines 9-24 cited by the Examiner, *Foti II* states:

In yet another aspect, the present invention is an all-IP network in which call processing of a call to a called MS is performed by a plurality of CSCFs. The network includes [1] a Home Subscriber Server (HSS) that stores location information for the called MS, [2] a location server that stores a transport address for the called MS, and [3] a Domain Name Server (DNS) that stores an address for a Home CSCF for the called MS. A relationship function is implemented in each of the plurality of CSCFs, and determines whether any CSCF that receives a call setup message is the Home CSCF for the called MS, a Serving CSCF for the called MS, or neither a Home CSCF nor a Serving CSCF for the called MS. Each CSCF also includes defined call processing functions that are selectively performed, depending on a result determined by the relationship function.

(Underlining, bolding, italics, and reference numerals added). Thus, the recited passage of *Foti II* teaches a network having three distinct elements: 1) an HSS, 2) a location server, and 3) a domain name server. For at least four reasons, the recited passage of *Foti II*, and in fact the entirety of *Foti II*, fails to teach “providing the TA and an address of the S-CSCF to a Home Subscription Server (HSS) for storage at the HSS” and “receiving the TA from the HSS in response to a loss of the TA by the S-CSCF such that the TA is restored at the S-CSCF” as recited in Claims 1, 8, and 29.

First, the recited passage of *Foti II* teaches that the transport address is stored in the location server and not in the HSS which is contrary to the plain language of the claim. Second, the recited passage teaches that the transport address of the called MS not the registration request of the subscriber sending the registration request is stored in the location server again contrary to the plain language of the claim. Third, the recited passage of *Foti II* teaches that the HSS stores location information and not the transport address which is contrary to the plain language of the claim. Fourth, the recited passage of *Foti II* teaches that the location information of the called MS not the transport address of the subscriber sending the registration request is stored at the HSS again contrary to the plain language of the claim. Therefore, Applicants again respectfully submit that the recited passage of *Foti II* does not teach “providing the TA and an address of the S-CSCF to a Home Subscription Server (HSS) for storage at the HSS” nor does it teach “receiving the TA from the HSS in response to a loss

of the TA by the S-CSCF such that the TA is restored at the S-CSCF” as recited in Claims 1, 8, and 29.

*Foti II* fails to provide any such teaching because *Foti II* is not directed to restoring lost data to a S-CSCF. *Foti II* is directed towards providing “a CSCF and method by which any CSCF receiving a call setup message can determine what call processing functions it should perform.”

As a result, *Bharatia*, *Foti I*, and *Foti II* fail to teach, suggest, or disclose all of the elements of at least independent Claims 1, 8, and 29. An obviousness rejection cannot be properly maintained where the references used in the rejection do not disclose all of the recited claim elements. Claims 31 and 32 depend from Claims 1 and 29, respectively. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 1, 8, 29, 31, and 32.

#### **IV. Rejection of Claims 3-5, 7, 10-12, and 14 under 35 U.S.C. § 103(a)**

In section 7 of the Office Action, Claims 3-5, 7, 10-12, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bharatia* in view of *Foti I* and further in view of *Foti II* and U.S. Patent No. 6,163,532 to Taguchi *et al.* (*Taguchi*). Applicants respectfully disagree and respectfully submit that *Bharatia*, *Foti I*, *Foti II*, and *Taguchi*, alone and in combination, fail to teach, suggest, or describe all of the elements of at least independent Claims 1, 5, 8, and 12.

##### **A. Claims 3, 4, 10, and 11**

Claims 3 and 4 depend from Claim 1. Claims 10 and 11 depend from Claim 8. As discussed in section III. above, *Bharatia*, *Foti I*, and *Foti II* fail to teach, suggest, or disclose “providing the TA and an address of the S-CSCF to a Home Subscription Server (HSS) for storage at the HSS” and “receiving the TA from the HSS” as recited in Claim 1, and similarly recited in Claim 8. *Taguchi* also fails to teach anything whatsoever related to “providing the TA and an address of the S-CSCF to a Home Subscription Server (HSS) for storage at the HSS” and “receiving the TA from the HSS” as recited in Claim 1, and similarly recited in Claim 8.

Therefore, *Bharatia*, *Foti I*, *Foti II*, and *Taguchi* fail to teach, suggest, or disclose all of the elements of at least independent Claims 1 and 8. An obviousness rejection cannot be properly maintained where the references used in the rejection do not disclose all of the recited claim elements. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 3, 4, 10, and 11 for at least this reason.

*B. Claims 5, 7, 12, and 14*

Neither *Bharatia*, *Foti I*, *Foti II*, nor *Taguchi* teach “storing the TA in a non-volatile memory of the S-CSCF” and “restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF” as recited in Claim 5, and similarly recited in Claim 12.

First, on page 11 of the Office Action, the Examiner states:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., obtains the called subscriber's transport address) are not recited in the rejected claim(s).

(Underlining added). Applicants assert that the Examiner misunderstood Applicants assertion which had nothing to do with the claims including the recited language. Applicants were merely pointing out that *Foti II* was silent to how the CSCF “obtains the called subscriber's transport address.”

Second, on pages 11-12 of the Office Action, the Examiner states:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, *Foti et al* (US 6,654,606) (**column 2, lines 9-24**, where *Foti teaches restoring the TA to the S-CSCF from the memory in response to a loss of the TA by the S-CSCF*, and see *Taguchi*, where *Taguchi* teaches storing data in a nonvolatile memory (see column 16, lines 53-58), and the combination of *Bharatia*, *Foti* (US 6,839,323), *Foti et al* (US 6,654,606) and *Taguchi* indeed teaches storing the TA in a non-volatile memory of the S-

CSCF" and "restoring the TA to the S-CSCF from the nonvolatile memory in response to a loss of the TA by the S-CSCF" as recited in claims 5 and 1[2].

(Pgs. 11-12; bolding in original, underlining added). Applicants respectfully submit that the references were not being attacked individually. Applicants instead discussed how each of the references failed to teach "storing the TA in a non-volatile memory of the S-CSCF" and "restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF" as recited in Claims 5 and 12.

In fact, on pages 6-7 of the Office Action, the Examiner recognizes that:

The combination of *Bharatia* and *Foti* (US 6,839,323) does not specifically disclose ... storing the TA in the S-CSCF, and restoring the TA to the S-CSCF in response to a loss of the TA by the S-CSCF.

*Foti* (US 6,654,606) teaches ... storing the TA in the S-CSCF (see column 3, lines 11-34), and restoring the TA to the S-CSCF in response to a loss of the TA by the S-CSCF (see column 3, lines 11-34).

Thus, the Examiner acknowledges that *Bharatia* and *Foti I* fail to teach at least these elements of Claims 5 and 12. The Examiner looks to *Foti II* to provide these teachings and to *Taguchi* merely to disclose "storing data in a non-volatile memory." (Pg. 7). Applicants respectfully disagree with the Examiner's characterization of *Foti II* and again submit that *Foti II* fails to teach at least "storing the TA in the S-CSCF (see column 3, lines 11-34), and restoring the TA to the S-CSCF in response to a loss of the TA by the S-CSCF (see column 3, lines 11-34)" as stated by the Examiner.

At column 3, lines 11-34 cited by the Examiner, *Foti II* states:

At step 12, the CSCF determines whether or not it is the Home CSCF of the called subscriber. If not, the process moves to step 13 where the CSCF determines from its internal database whether or not it is currently serving the called subscriber. If not, the process moves to step 14 where a query is sent to a Domain Name Server (DNS) to find the next hop address for the setup message. If the CSCF is currently serving the called subscriber, the process moves to step 15 where the CSCF obtains the **called subscriber's transport address** and proceeds to set up the call.

Returning to step 12, if the CSCF determines that it is the Home CSCF of the called subscriber, the process moves to step 16 where the CSCF checks its internal database to determine whether or not the called subscriber is located in the home area. If so, the process moves to step where the CSCF obtains the called subscriber's transport address and proceeds to set up the call. If the called subscriber is not located in the home area, the process moves instead to step 17 where the CSCF obtains location information from the subscriber's Home Subscriber Server (HSS). The HSS returns the address of a Visited CSCF, and the CSCF forwards the call setup message to the Visited CSCF at step 18.

(Underlining and bolding added). Again, Applicants point out that, in the cited passage, *Foti II* fails to describe how the CSCF “obtains the called subscriber's transport address.” Thus, *Foti II* is silent as to how the CSCF “obtains the called subscriber's transport address.” Therefore, the recited passage of *Foti II* does not teach, suggest, or describe “storing the TA in a non-volatile memory of the S-CSCF” and “restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF” as recited in Claims 5 and 12.

The recited passage of *Foti II* also describes obtaining the transport address of the called subscriber and not a Care of Address of the subscriber sending the registration request. Therefore, the recited passage of *Foti II* again fails to teach, suggest, or describe “storing the TA in a non-volatile memory of the S-CSCF” and “restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF” as recited in Claims 5 and 12.

*Foti II* further states:

Therefore, referring briefly to FIG. 1, it can be seen that the process proceeds from step 11 where the Fast Setup message is received, to steps 12, 13, and 15 where it is determined that the Visited CSCF should obtain the called subscriber's transport address and set up the call. Therefore, referring once again to FIG. 2, the Visited CSCF sends a Routing message 48 for the Destination Alias to the Location Server 23 in the Serving Network 31. This results in a Response to the Visited CSCF at 49 which indicates the transport address of the Terminating ME 22.



(Col. 4, lines 39-49; underlining and bolding added). Thus, *Foti II* teaches that the CSCF obtains the TA from the Location Server as discussed in Section III. above. Therefore, according to *Foti II*, the transport address is stored in the Location Server not the CSCF. As a result, *Foti II* again fails to teach, suggest, or describe “storing the TA in a non-volatile memory of the S-CSCF” and “restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF” as recited in Claims 5 and 12.

*Taguchi* describes “a communication system across an in-office PC system (10) and an in-enterprise LAN system.” (Abstract). *Taguchi* discloses “[t]he control unit includes a memory unit such as RAM [or] hard disk. (Column 16, lines 53-54). As such, *Taguchi* discloses the mere existence of a memory unit. *Taguchi* fails to disclose anything relating to the memory unit being part of an S-CSCF or the transport address being stored on or restored from the memory unit of an S-CSCF. Thus, *Taguchi* fails to teach anything whatsoever related to “storing the TA in a non-volatile memory of the S-CSCF” and “restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF” as recited in Claims 5 and 12. As a result, *Bharatia*, *Foti I*, *Foti II*, and *Taguchi* fail to teach at least these features of Claims 5 and 12.

Therefore, *Bharatia*, *Foti I*, *Foti II*, and *Taguchi* fail to teach, suggest, or disclose all of the elements of at least independent Claims 5 and 12. Claim 7 depends from Claim 5. Claim 14 depends from Claim 12. An obviousness rejection cannot be properly maintained where the references used in the rejection do not disclose all of the recited claim elements. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 5, 7, 12, and 14.

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the

credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date July 2, 2009

By



FOLEY & LARDNER LLP  
Customer Number: 23524  
Telephone: (608) 258-4263  
Facsimile: (608) 258-4258

Callie M. Bell  
Attorney for Applicant  
Registration No. 54,989